

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Response to Amendment

2. Applicant's amendment filed June 12, 2008, has been entered. Claims 22 and 24 have been amended as requested. Claims 1-21 and 25-29 are cancelled. Thus, the pending claims are 22-24.

3. Said amendment is sufficient to withdraw the rejection of claims 22-24 under 35 U.S.C. 112, second paragraph, as set forth in section 1 of the last Office Action (Final Rejection mailed 02/13/08).

Claim Rejections - 35 USC § 102/103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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5. Claims 22-24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 00/65140 issued to Matsunaga et al. as set forth in section 3 of the last Office Action.

6. Claims 22-24 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 2003/0152743 issued to Matsunaga et al. as set forth in section 4 of the last Office Action.

[Note US 2003/0152743 is the English language equivalent of the Japanese language WO 00/65140.]

Applicant has amended the claims to limit the carpet to comprising the multifilament crimped yarn obtained by drawing a non-drawn yarn in a two-step process and then crimping said yarn with an apparatus that utilizes heated air. While the Matsunaga references only disclose a one-step drawing process, the claims are not drawn to a process of making the carpet. Rather, applicant claims a carpet comprising pile yarn produced by a particular process (i.e., product-by-process limitations). As such, the amendment to the claims limiting the process of making the pile yarn is insufficient to overcome the standing rejections since it still has not been shown the yarn of Matsunaga does not produce the product as presently claimed. There is nothing on record evidencing the two-step drawing process inherently produces a patentably distinct process from the known prior art process. For example, applicant has not shown that the yarn of Matsunaga has a crimp elongation rate, boiling water shrinkage, and/or breaking strength outside of the range claimed by applicant.

Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does

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not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious variant from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964. The burden has been shifted to the Applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289.

To reiterate, the invention of claims 22-24 is taught by the Matsunaga references with the exception of the presently claimed properties of crimp elongation rate, boiling water shrinkage, and breaking strength. Although the references do not explicitly teach said property limitations, it is reasonable to presume that said limitations are inherent to the disclosed Matsunaga invention. Support for said presumption is found in the use of similar materials (i.e., crimped multifilament yarn of polylactic acid having a melting point greater than 130°C) and in the similar production steps (i.e., tufting said crimped multifilament yarn into a base cloth) used to produce the tufted carpet. The burden is upon the applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 495. In the alternative, the claimed properties would obviously have been provided by the process disclosed by Matsunaga. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. Since applicant has not adequately met the burden of showing the prior art does not inherently possess the claimed properties, the above rejections stand.

Response to Arguments

7. Applicant's arguments filed with the RCE have been fully considered but they are not persuasive.

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8. Specifically, applicant traverses the rejection by asserting the presently claimed process limitations do not generate a lot of loose fibers (Amendment, paragraph spanning pages 3-4). Additionally, applicant argues the one-step process of Matsunaga does not produce yarns which crimp well at low temperatures (Amendment, paragraph spanning pages 3-4). In response, it is noted that the features upon which applicant relies (i.e., lack of loose fibers and crimping well at low temperatures) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, applicant asserts the present invention is different from that disclosed by Matsunaga in that the prior art discloses heat sealing of the back of the carpet pile to fix the tufted yarns into place (Amendment, paragraph spanning pages 3-4). In response, it is noted that applicant's claims do not exclude such a heat sealed carpet back. Hence, applicant's arguments are found unpersuasive and the above rejections are maintained.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached at 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cheryl Juska/
Primary Examiner
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cj
August 13, 2008